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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,736	11/29/2000	Samuel Schindler	ESEC-P32US-D1	3137

7590

08/13/2003

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EXAMINER
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CHANG, RICK KILTAE

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 08/13/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

**Office Action Summary**

Application No.

09/726,736

Applicant(s)

SCHINDLER, SAMUEL

Examiner

Rick K. Chang

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The proposed drawing correction filed on 2/24/03 has been disapproved because it is not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v).

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15-20, 25 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Genov et al (US 5,064,340).

Genov discloses 32 is a chip gripper; 12 and 18 levers; toothed wheels and belts (Fig. 5) moves 32, 12 and 18; a plurality of shafts as Fig. 1; a drive mechanism is housed in 38; levers arranged with toothed wheels and belts provide various different angles between levers; and 32 is rigidly connected to the opposing end of the second pivoted lever by a shaft, bearings and screws (Fig. 1).

**NOTE: Please provide reference numerals (either in parentheses next to the claimed limitation or in a table format with one column listing the claimed limitation and another column listing corresponding reference numerals in the remark section of the response to the Office Action) to all the claimed limitations as well as support in the disclosure for better clarity. Applicants are duly reminded that a full and proper response to this Office**

Art Unit: 3729

**Action that includes any amendment to the claims and specification of the application as originally filed requires that the applicant point out the support for any amendment made to the disclosure, including the claims. See 37 CFR 1.111 and MPEP 2163.06.**

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-24 and 26-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Genov et al (US 5,064,340) in view of Parker (US 5,934,147).

Genov fails to disclose delimiters and 1:3 gear ratio.

Parker discloses Fig. 3 shows delimiters thereby limiting the rotational movement of the gripper to allow for picking up heavy or odd size electronic components at certain locations of the apparatus' reach without manipulating any one of the levers.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Genov by providing delimiters, as taught by Parker, for the purpose of limiting the rotational movement of the gripper to allow for picking up heavy or odd size electronic components at certain locations of the apparatus' reach without manipulating any one of the levers.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a gear ratio of 1:3 because Applicant has

Art Unit: 3729

not disclosed that such gear ratio provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the gear and toothed belt system as taught by Genov because the outcome of the apparatus is the same.

**NOTE: Please provide reference numerals (either in parentheses next to the claimed limitation or in a table format with one column listing the claimed limitation and another column listing corresponding reference numerals in the remark section of the response to the Office Action) to all the claimed limitations as well as support in the disclosure for better clarity. Applicants are duly reminded that a full and proper response to this Office Action that includes any amendment to the claims and specification of the application as originally filed requires that the applicant point out the support for any amendment made to the disclosure, including the claims. See 37 CFR 1.111 and MPEP 2163.06.**

***Response to Arguments***

6. Applicant's arguments filed 6/13/03 have been fully considered but they are not persuasive.

In response to applicant's argument that the invention recites in the preamble "An apparatus used as a component of a die bonder for placing a semiconductor chip on a substrate", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA

Art Unit: 3729

1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Genov discloses all the claimed limitations as recited in the 102 rejection.

Genov's apparatus discloses the same arrangement of its internal components as the invention because it recites the same structural limitations. "for . . . position" is only an intended use limitation.

The limitations as stated in the claims do not restrict Genov from having more than as stated in the claimed limitations.

Where the patent is classified or what kind of claims are in the Genov reference, Genov discloses the structural limitations as recited in the claimed limitations, except for delimiter and gear ratio.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Genov by providing delimiters, as taught by Parker, for the purpose of limiting the rotational movement of the gripper to allow for picking up heavy or odd size electronic components at certain locations of the apparatus' reach without manipulating any one of the levers.

#### ***Interviews After Final***

**7. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.**

#### ***Conclusion***

Art Unit: 3729

8. **Please provide reference numerals (either in parentheses next to the claimed limitation or in a table format with one column listing the claimed limitation and another column listing corresponding reference numerals in the remark section of the response to the Office Action) to all the claimed limitations as well as support in the disclosure for better clarity. Applicants are duly reminded that a full and proper response to this Office Action that includes any amendment to the claims and specification of the application as originally filed requires that the applicant point out the support for any amendment made to the disclosure, including the claims. See 37 CFR 1.111 and MPEP 2163.06.**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick K. Chang whose telephone number is (703) 308-4784. The examiner can normally be reached on 5:30 AM to 1:30 PM, Monday through Friday, except for maxi-flex day off (any one of working days).

Art Unit: 3729

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to be 'RC', written over a horizontal line.

**RICHARD CHANG  
PRIMARY EXAMINER**

RC  
August 13, 2003